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EXAMINER

ABDI, KAMBIZ

ART UNIT PAPER NUMBER

3621

DATE MAILED: 05/16/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/910,256

Applicant(s)

ALTHOFF ET AL.

Examiner

Kambiz Abdi

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 20 April 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-37 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-37 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

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DETAILED ACTION

1. The prior office actions are incorporated herein by reference. In particular, the observations with respect to claim language, and response to previously presented arguments.
 - Claims 1-37 have been considered
 - Claims 14,40-53 are amended.
2. The examiner, based on the corrections by the applicant, has withdrawn objections to specifications and claims.

Response to Amendment

Declaration Under 37 CFR 1.131: Ineffective

3. Paragraphs 1-4 of the Declaration makes general references to the named inventor and the prosecution history of the application including the applied prior arts and pending claims.
4. Formal Requirements of Affidavits and Declarations (MPEP 715.04)

The following parties may make an affidavit or declaration under 37 CFR 1.131:

- (A) All the inventors of the subject matter claimed.
- (B) An affidavit or declaration by less than all named inventors of an application is accepted where it is shown that less than all named inventors of an application invented the subject matter of the claim or claims under rejection. For example, one of two joint inventors is accepted where it is shown that one of the joint inventors is the sole inventor of the claim or claims under rejection.
- (C) If a petition under 37 CFR 1.47 was granted or the application was accepted under 37 CFR 1.42 or 1.43, the affidavit or declaration may be signed by the 37 CFR 1.47 applicant or the legal representative, where appropriate.
- (D) The assignee or other party in interest when it is not possible to produce the affidavit or declaration of the inventor. Ex parte Foster, 1903 C.D. 213, 105 O.G. 261 (Comm'r Pat. 1903).

However, the Declaration is only signed by the attorney, Mr. George W. Hartnel, III and none of the inventors of record have signed the declaration, as well as none of the aforementioned conditions have been met, therefore, declaration does not comply with the formal requirements set forth.

Accordingly, the declaration is of no effect.

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For the purpose of compact prosecution, the examiner provides a brief explanation of other deficiencies found in the Declaration. Note that these comments are not meant to be comprehensive. They are merely designed to assist Applicants should they choose to file additional affidavits.

Insufficient Evidence of Conception, Reduction to Practice and Diligence Before References Date.

5. Conception:

Conception is the mental part of the inventive act, but it must be capable of proof, as by drawings, complete disclosure to another person, etc. In *Mergenthaler v. Scudder*, 1897 C.D. 724, 81 O.G. 1417 (D.C. Cir. 1897), it was established that conception is more than a mere vague idea of how to solve a problem; the means themselves and their interaction must be comprehended also (MPEP 715.04, page 70-250)

No clear explanation has been given as to what if there are any exhibits, which might show and HOW they support conception of the CLAIMED invention.

Accordingly, Applicant has not met the burden of showing conception prior to the date of references.

6. Reduction to Practice:

715.07(a) -Where conception occurs prior to the date of the reference, but reduction to practice is afterward, it is not enough merely to allege that applicant or patent owner had been diligent. *Ex parte Hunter*, 1889 C.D. 218, 49 O.G. 733 (Comm'r Pat. 1889). Rather, applicant must show evidence of facts establishing diligence.

Applicant has not provided any indication of what was tested and whether it was commensurate with the claims. Furthermore, a mere statement as to testing is inadequate. Applicant must provide evidence, which will allow the Examiner to conclude that the invention was tested and worked for its intended purpose.

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7. In conclusion, the Affidavit fails because of improper execution, no showing of reduction to practice of the claimed invention, no showing of conception of the claimed invention and no showing of diligence.

8. Therefore, the rejection mailed on October 22, 2004, of the claims as they have been presented as in the previous rejection stands (See Below).

Claim Rejections - 35 USC § 102

9. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

10. Claims 1-36 rejected under 35 U.S.C. 102(e) as being anticipated by U.S. Patent Application Publication No. US 2003/0154405 A1 to John Harrison.

11. As per claim 1, Harrison discloses a method for carrying out over a network at least one verified, remote electronic transaction between at least one user and at least one merchant by providing to a merchant's server verified user information, which is necessary to complete the verified transaction, the method comprising:

- interfacing a machine-readable data structure of the user with a digital, electronic device, wherein the digital, electronic device is connected to the network (See Harrison abstract, paragraphs [0021], [0022], [0090], and [0130], where a machine-readable data structure corresponds to smart card and smart card reader corresponds to digital , electronic device);
- providing an access code via the digital, electronic device to unlock the machine-readable data structure and to thereby access a database of verifiable user information contained therein (See

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Harrison abstract, paragraphs [0023], [0091], [0094], [0132], and [0132], where access code corresponds to a PIN or PASSWORD); and

- providing the verifiable user information to the merchant over a communication link of the network to complete the transaction (See Harrison paragraphs [0015]-[0022] and [0132]).

12. As per claim 2, Harrison discloses the method of claim 1, further; Harrison discloses, verifiable user information is compared with similar user information residing on a verifying server on the network (See Harrison paragraphs [0015]-[0022]).

13. As per claim 3. The method of claim 1, further; Harrison discloses, the machine-readable data structure is selected from the group consisting of an integrated circuit card, a magnetic stripe card, and a bar coded card (See Harrison paragraphs [0090] and [0130]).

14. As per claim 4, Harrison discloses the method of claim 1, further; Harrison discloses, at least one merchant is a verifiable merchant (See Harrison paragraph [0132] where the vendor is corresponding to merchant).

15. As per claim 5, Harrison discloses the method of claim 1, further; Harrison discloses, the machine-readable data structure is unlocked by providing an access code through the digital, electronic device that matches a previously registered personal security code (See Harrison paragraphs [0023] and [0094]).

16. As per claim 6, Harrison discloses the method of claim 5, further; Harrison discloses, the previously registered personal security code is contained in unsecured memory on the machine-readable data structure (See Harrison paragraph [0023]).

17. As per claim 7, Harrison discloses the method of claim 1, further; Harrison discloses,

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a first communication link between said digital, electronic device and the merchant's server is established following the unlocking of the machine-readable data structure (See Harrison paragraph [0132], where the vendor 70 corresponds to merchant server and a first communication link corresponds to communication link 42 internet).

18. As per claim 8, Harrison discloses the method of claim 1, further; Harrison discloses, the communication link between the digital, electronic device and the merchant's server is established through a second communication link from said digital, electronic device to a verifying server and then through a third communication link from said verifying server to said merchant's server (See Harrison paragraph [0132], where in figure 2, the vendor 70 corresponds to merchant server and a second communication link corresponds to communication link 41a and a third communication link corresponds to 41b).

19. As per claim 9, Harrison discloses the method of claim 1, further; Harrison discloses, verified user information is transmitted to at least one merchant's server to populate at least one merchant's check-out form (See Harrison paragraphs [0112] and [0135]).

20. As per claim 10, Harrison discloses the method of claim 9, further; Harrison discloses, verified user information is transmitted to at least one merchant's server to populate at least one merchant's check-out form, following verification of the user's information at a verifying server (See Harrison paragraphs [0112] and [0135]).

21. As per claim 11, Harrison discloses the method of claim 9, further; Harrison discloses, said check-out form is populated manually by the user (See Harrison paragraphs [0087] and [0132]).

22. As per claim 12, Harrison discloses the method of claim 9, further; Harrison discloses,

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said check-out form is populated automatically (See Harrison paragraphs [0112] and [0135]).

23. As per claim 13, Harrison discloses the method of claim 1, further; Harrison discloses, verified user information is transmitted to at least one merchant's server by automatically populating a merchant's order database and transaction systems (See Harrison paragraphs [0112], [0132], and [0135]).

24. As per claim 14, Harrison discloses the method of claim 13, further; Harrison discloses, verified user information is transmitted to at least one merchant's server by automatically populating a merchant's order database and transaction systems following verification of the user's information at a verifying server (See Harrison paragraphs [0112], [0132], and [0135]).

25. As per claim 15, Harrison discloses the method of claim 1, further; Harrison discloses, the merchant's server contains server-side software to accept direct transmission of verified user information from the machine-readable data structure, without using forms (See Harrison paragraph [0132]).

26. As per claim 16, Harrison discloses the method of claim 1, further; Harrison discloses, the network is selected from the group consisting of local area networks, wide area networks, the Internet, and Wireless and Mobile networks (See Harrison paragraph [0013]).

27. As per claim 17, Harrison discloses the method of claim 1, further; Harrison discloses, the additional steps of:
providing authorization from the user to complete said verified transaction;
completing said verified transaction;
providing at least one message to the merchant, indicating that said verified transaction comprises a valid, card present equivalent transaction; and

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providing at least one message, comprising at least one transaction number, to the user's digital, electronic device to confirm the sale (See Harrison paragraphs [0014]-[0020], [0045], [0052] and [0202] .

28. As per claim 18, Harrison discloses a method for providing verified information about at least one user over a network to at least one merchant during at least one electronic transaction, the method comprising the steps:

- providing at least one access code provided by the at least one user and unique user information to at least one verifying server, wherein said verifying server is connected to the network;
- verifying said access code and unique user information; and
- providing verified user information to the at least one merchant (See Harrison paragraphs [0009], [0014]-[0019], and [0024], where access code and unique user information correspond to a password and ID and verifying server corresponds to secure server).

29. As per claim 19, Harrison discloses the method of claim 18, further; Harrison discloses, said access code is verified by comparing said access code with a previously registered security code stored on a machine-readable data structure (See Harris paragraph [0094]).

30. As per claim 20, Harrison discloses the method of claim 19, further; Harrison discloses, said access code is verified by presenting said access code through a digital, electronic device to the machine-readable data structure (See Harris paragraph [0130]).

31. As per claim 21, Harrison discloses the method of claim 18, further; Harrison discloses, said unique user information is released for verification against similar data stored in at least one database of the at least one verifying server (See Harris paragraphs [003], [0130], and [0132]).

32. As per claim 22, Harrison discloses the method of claim 21, further; Harrison discloses,

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said unique user information is released for verification against similar data stored in at least one database of the at least one verified server upon verification of the access code (See Harris paragraphs [003], [0130], and [0132]).

33. As per claim 23, Harrison discloses the method of claim 18, further; Harrison discloses, the network is selected from the group consisting of local area networks, wide area networks, the Internet, and Wireless and Mobile networks (See Harrison paragraph [0013]).

34. As per claim 24, Harrison discloses a system enabling a user to complete one or more verified, remote electronic transactions over a network with at least one merchant, said merchant having a server, wherein said verified transactions are completed by providing the merchant's server with verified user information, the system comprising:

- a network (See Harrison paragraph [0013]);
- at least one remote verifying server, wherein said remote verifying server is connected to the network and is capable of receiving and verifying verified user information (See Harrison paragraphs [0014]-[0019]);
- at least one remote server maintained by a merchant, wherein the merchant's at least one remote server is connected to the network and is capable of accessing said remote verifying server to receive verified user information therefrom (See Harrison paragraphs [0014]-[0019]);
- at least one remote digital, electronic device (corresponding to kiosk or a user terminal), that is maintained by the user or by a third party wherein said digital, electronic device is connected to the network (corresponding to Internet) and is capable of accessing said verifying server to transmit verified user information and said remote server maintained by a merchant to initiate and complete said verified, remote electronic transactions (See Harrison paragraph [0130]); and
- a machine-readable-data structure, having at least one secure memory cache, which interfaces with said digital, electronic device (See Harrison paragraphs [0023] and [0094], where a machine-

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readable-data structure corresponds to smart card).

35. As per claim 25, Harrison discloses the system of claim 24, further; Harrison discloses, the system further comprises a registered personal security code that is stored in said secure memory cache of said machine-readable data structure (See Harrison paragraphs [0023] and [0094]).

36. As per claim 26, Harrison discloses the system of claim 24, further; Harrison discloses, the machine-readable data structure comprises at least one of an integrated circuit card, a magnetic stripe card, or a bar coded card (See Harrison paragraphs [0023] and [0094]).

37. As per claim 27, Harrison discloses the system of claim 26, further; Harrison discloses, the integrated circuit card, having a surface, further comprises:
at least one internal microprocessor, at least one internal semiconductor memory, having a secured first portion for storing verifiable user information and an unsecured second portion, wherein said at least one internal semiconductor memory is controlled by said at least one internal microprocessor; and at least one mass-storage memory, wherein said at least one mass storage memory is accessible from the surface of the card (See Harrison paragraphs [0023] and [0094]).

38. As per claim 28, Harrison discloses the system of claim 24, further; Harrison discloses, said machine-readable data structure can be unlocked by a security algorithm (See Harrison paragraphs [0022], [0023], and [0094]).

39. As per claim 29, Harrison discloses the system of claim 28, further; Harrison discloses, said machine-readable data structure can be unlocked by inputting an access code (See Harrison paragraphs [0022], [0023], and [0094]).

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40. As per claim 30, Harrison discloses the system of claim 29, further; Harrison discloses, said machine-readable data structure is unlocked after the access code inputted by the user is verified against a previously registered security code that is stored in said secured first portion of said internal semiconductor memory (See Harrison paragraphs [0022], [0023], and [0094]).

41. As per claim 31, Harrison discloses the system of claim 30, further; Harrison discloses, said previously registered security code is resident in one or more memory on the machine-readable data structure (See Harrison paragraphs [0022], [0023], and [0094]).

42. As per claim 32, Harrison discloses the system of claim 29, further; Harrison discloses, said system further comprises software capable of providing verified user information to at least one verifying server for verification upon prior successful access code verification (See Harrison paragraphs [0022], [0023], and [0094]).

43. As per claim 33, Harrison discloses the system of claim 24, further; Harrison discloses, at least one verifying server provides verified user information to said merchant's server to populate a merchant's check-out form contained therein (See Harrison paragraphs [0112], [0132], and [0135]).

44. As per claim 34, Harrison discloses the system of claim 33, further; Harrison discloses, said at least one verifying server provides verified user information to said merchant's server by automatically populating an order database and transaction system (See Harrison paragraphs [0112], [0132], and [0135]).

45. As per claim 35, Harrison discloses the system of claim 33, further; Harrison discloses,

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said merchant's server contains server-side software to accept direct transmission of the user's machine-readable data, without using forms (See Harrison paragraph [0132]).

46. As per claim 36, Harrison discloses the system of claim 35, further; Harrison discloses,

said direct transmission of the user's machine readable data is stored originally on the user's machine-readable data structure (See Harrison paragraph [0132]).

Claim Rejections - 35 USC § 103

47. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

48. Claim 37 is rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent Application Publication No. US 2003/0154405 A1 to John Harrison.

49. As per claim 37, Harrison discloses the system of claim 33, further; Harrison discloses,

the user manually populates the merchant's check-out form (See Harrison paragraph [0132]) by dragging verified user information from at least one pop-up window and dropping the dragged information into an appropriate location of the merchant's check-out form.

What is not explicitly disclosed by Harrison is the drag and drop functionality of populating a form in a graphical user interface.

However, The examiner takes Official Notice that the process of drag and drop of visual items such as text or graphics within a graphical user interface from one window to another window is an old and well known practice in the art as an easy way to populate new windows with old items of interest without retyping or recreating the content.

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Therefore, it would have been obvious to one having ordinary skill in the art at the time the current invention was made to have included the drag and drop functionality to the invention for the motivation of saving time and accuracy of populating forms without retyping the text.

50. Examiner has pointed out particular references contained in the prior arts of record in the body of this action for the convenience of the applicant. Although the specified citations are representative of the teachings in the art and are applied to the specific limitations within the individual claim, other passages and figures may apply as well. It is respectfully requested from the applicant, in preparing the response, to consider fully the entire references as potentially teaching all or part of the claimed invention, as well as the context of the passage as taught by the prior arts or disclosed by the examiner.

Conclusion

51. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

52. A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

53. Any inquiry of a general nature or relating to the status of this application or concerning this communication or earlier communications from the examiner should be directed to **Kambiz Abdi** whose telephone number is **(571) 272-6702**. The Examiner can normally be reached on Monday-Friday,

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9:30am-5:00pm. If attempts to reach the examiner by telephone are unsuccessful, the Examiner's supervisor, **James Trammell** can be reached at **(571) 272-6712**.

54. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://portal.uspto.gov/external/portal/pair>.

55. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Any response to this action should be mailed to:

**Commissioner of Patents and Trademarks
Washington, D.C. 20231**

or faxed to:

(703) 305-7687 [Official communications; including After Final communications labeled "Box AF"]

(703) 308-1396 [Informal/Draft communications, labeled "PROPOSED" or "DRAFT"]

Hand delivered responses should be brought to the Examiner in the

Knox Building, 50 Dulany St. Alexandria, VA.

Kambiz Abdi
Examiner


May 9, 2005


JAMES R. TRAMMELL
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